

REMARKS

Claims 1-35 are currently pending. Claims 20, 21, 25-30, 34, and 35 were previously withdrawn from consideration. No claims are currently added, canceled, or amended. Reconsideration of the pending claims in light of the following remarks is respectfully requested.

§ 102 Rejections

Claims 31 and 32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,653,714 to Dietz et al. (“Dietz”). The PTO provides in MPEP § 2131 that “[t]o anticipate a claim, the reference must teach every element of the claim....”

Therefore, to sustain the rejection of these claims Dietz must teach all of the claimed elements of each claim.

With respect to independent claim 31, Dietz at least fails to disclose “a pair of eccentric guide members movably engaged between said guide body and said bone removal device.” As described and shown in Fig. 1 of Dietz, the inner frame 28, including the pair of parallel rods 32, rotate about a central axis of rotation defined by screws 30. The Dietz patent further states, “[s]crews 30 together define the axis of rotation of inner frame 28. . . Inner frame 28 includes a pair of parallel rods 32. . .” (col. 2, lines 49-51). Thus, the parallel rods 32, cannot be considered eccentric because they both move only around a common fixed axis of rotation as described, no variation appears possible. Thus, for at least this reason Dietz fails to teach all of the claimed elements of claim 31.

Therefore, Applicants respectfully request that the Examiner withdraw the §102(b) rejection as to independent claim 31 and claim 32 which depends from and further limits claim 31. Claim 33 depends from and further limits claim 31 and is therefore also believed to be in condition for allowance.

§ 103 Rejections

Claims 1-15, 17-18, 20, and 23-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dietz in view of U.S. Patent No. 4,892,093 to Zarnowski et al. (“Zarnowski”). Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to these claims.

As the PTO recognizes in MPEP §2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. . .

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

First, even when combined, the references do not teach the claimed subject matter because neither Dietz, nor Zarnowski, nor the combination disclose movably engaged guide members substantially aligned along an alignment axis substantially parallel to the longitudinal axis of the bone removal device. As the examiner has recognized, Dietz does not disclose guide members being substantially aligned along an alignment axis substantially parallel to the axis of the bone removal device. Zarnowski, likewise, fails to disclose this claim element. As shown in FIGS. 2-5, saw blade 50 extends transverse to the bars 34, 36, not parallel. The examiner suggests that the saw blade may be slanted or angled until it is substantially aligned with the bars, however, the considerable width of the saw blade 50 and the similarly considerable width and depth of the side members 30 would completely prevent anything approaching parallel alignment between the saw blade and the bars 34, 36. Like Dietz, the figures and related disclosure of Zarnowski contemplate only a substantially perpendicular arrangement between the saw blade 50 and the bars 34, 36. For at least this reason, the examiner's burden of factually supporting a prima facie case of obviousness has clearly not been met, and the rejection under 35 USC §103 should be withdrawn.

Second, the references are not properly combinable if their intended function is destroyed. The milling guide 40 is a basic and integral component of all embodiments disclosed in the Dietz patent. In defining the field of the invention, Dietz states, “[t]his invention relates to cutting or milling guides. . .” (col. 1, line 5). Eliminating the milling guide 40 in accordance with Zarnowski, as suggested by the examiner to permit slanted and angled milling, would destroy an apparently fundamental component of the Dietz patent. The removal of the milling guide in combination with the rotatable inner frame 28 suggested by the examiner would permit a seemingly unacceptable and unsafe range of motion for the milling burr. Thus, for at

least this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 USC §103 should be withdrawn.

Finally, the combination of references is improper since neither Dietz nor Zarnowski teaches, or even suggests, the desirability of the combination proposed. MPEP §2142 provides:

... the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. . . . The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'

Neither Dietz nor Zarnowski suggests the desirability of removing the milling guide of Dietz to achieve "guide members substantially aligned along an alignment axis substantially parallel to the longitudinal axis of the bone removal device" because, as discussed above, the elimination of the milling guide is NOT desirable, but rather is fundamental to the teaching of Dietz. Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 USC §103 rejection and so the rejection should be withdrawn.

Claims 2-20, 23, and 24 depend from and further limit claim 1 and are therefore also believed to be in condition for allowance.

CONCLUSION

As a result of the foregoing, it is respectfully asserted that all pending claims are in condition for allowance. Should the Examiner deem that any further amendment is necessary to place this application in condition for allowance, the Examiner is invited to contact the undersigned at the below listed telephone number.

Respectfully submitted,



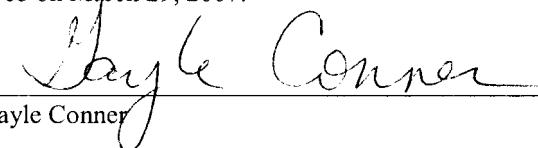
Julie M. Nickols

Registration No. 50,826

Date: March 29, 2007
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 972-739-8640
Facsimile: 214-200-0853
Attorney Docket No. PC869.02

Certificate of Service

I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on March 29, 2007.



Gayle Conner